

REMARKS

Applicants note with appreciation the indication that Claims 9, 13-14, 30, 33-34, and 45 would be allowable if rewritten to incorporate the limitations of the base claims and intervening claims from which they depend. Applicants have amended Claim 23, which is the base claim for Claim 34 to include the original limitations of Claim 34. Accordingly, Claim 23, and Claims 24-33 and 35-40, which depend therefrom, should be in condition for allowance without further remark.

The status of all claims is indicated above. Applicants note that new independent Claims 47-49, 54 and 59, and new dependent Claims 50-53, 55-58 and 60 have been added. New Claim 50 depends from new Claim 49, and new Claims 51-53 depend from original Claim 1. New Claims 55-58 depend from new Claim 54 and new Claim 60 depends from new Claim 59. Claim 34 is the only cancelled claim.

Claim Rejections – 35 U.S.C. § 112

Claims 2 and 6 are rejected under 35 U.S.C. § 112 for lack of antecedent basis for two specified claim terms. Claims 2 and 6 are amended to address these rejections. The amendments made to provide the required antecedent basis do not narrow the scope of these claims.

Claim Rejections – 35 U.S.C. § 102

Claim 1 is rejected as anticipated by MacAdam et al. U.S. Pat. No. 6,631,722 (“MacAdam”) and Smith et al. U.S. Pat. No. 6,041,790 (“Smith”). Applicants respectfully traverse each of these rejections.

Claim 1 recites, *inter alia*, a “cigarette” comprising “a tobacco rod” and “a cavity within said filter material, and extending from the proximal end of the filter element.” Smith cannot anticipate Claim 1 because it does not disclose “a cavity within said filter element, and extending from the proximal end of the filter element” away from a tobacco rod. The cavity shown in Smith does not extend from the end of the filter element, but rather is closed off from the end of the filter element.

MacAdam also does not anticipate Claim 1. As noted above, Claim 1 recites “a cavity within said filter element, and extending from the proximal end of the filter element.” MacAdam discloses a capsule 64 disposed in a cavity 63 between first and

second filtration sections 61 and 62 (Fig. 5). The cavity shown in Fig. 5 of MacAdam extends between two filter elements and therefore by definition does not extend from a location that is proximal to the tobacco rod. Fig. 6 of MacAdam discloses a thin rod 7 of activated carbon material encased by a wax coating 8 which is disposed in a filter element 3. The thin rod 7 of carbon material extends the entire length of the filter element 3 such that its end is not contained within the filter element. Accordingly, the thin rod 7 does not reside in a “cavity” in the filter element, as claimed.

In view of the foregoing differences between Claim 1 and the Smith and MacAdam references, Applicants respectfully request that the rejections based on these references be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 1-8, 10-12, 15-29, 31-32, 35-44 and 46 are rejected as being obvious over Berger et al. U.S. Pat. No. 3,599,646 (“Berger”) in view of Marmo et al. U.S. Pat. No. 4,311,720 (“Marmo”). Applicants traverse these rejections for the following reasons.

Claims 1-8, 10-12, 15-22, and 51-53 recite a “filter element incorporating filter material and having an end proximal to the tobacco rod,” and “a cavity within said filter material, and extending from the proximal end of the filter element.” The “proximal end” of the filter element is the end at which the open end of the cavity meets the end of the tobacco rod. The foregoing is supported by specification for the subject application which states at paragraph 44 that, “[t]he inner element 222 is open at its other end, and hence defines a cavity 214 that is open at the end proximal to the tobacco rod 195.” Berger discloses a filter element with a cavity 48 which is closed off from the tobacco rod by the permeable disc 50. In Berger, the cavity 48 does not have an open end that meets the end of the tobacco rod. Accordingly, the “cavity” in Berger does not extend from the “proximal end of the filter element,” and the rejection of Claims 1-8, 10-12 and 15-22 based on Berger should be withdrawn. New Claims 51-53, which also depend from Claim 1, should also be allowed.

Claim 34 depends from Claim 23 and was indicated to be allowable if rewritten in independent form to incorporate the limitations of base Claim 23. Applicants have amended Claim 23 to include the original limitations of Claim 34, and accordingly,

Claims 23-33 and 35-40, which depend therefrom, should now be in condition for allowance. Claim 34 is cancelled due to the fact that Claim 23, as amended, is equivalent in scope to original Claim 34.

Claim 41 is amended to recite, *inter alia*, that "said filter element is adapted to attain a shape functional for smoking after rupture of said capsule." Similarly, new Claims 47 and 48 recite that the claimed filter segment includes a "generally conically shaped cavity" and as a result is adapted to "decompress after breaking said capsule," and "attain a functional shape for smoking after being compressed to break said capsule," respectively. The prior art relied upon does not disclose that the filter elements described therein are so adapted, and accordingly, Claims 41-48 should be allowed.

New Claim 49 recites, *inter alia*, "at least one generally spherical breakable capsule disposed in the cavity, wherein the capsule has a diameter of at least about 2 mm." New Claim 50 recites that the capsule has a diameter of "at least about 3 mm." The prior art relied upon does not disclose these diameter limitations, and accordingly, Claims 49-50 should be allowed.

New Claim 54 recites, *inter alia*, "a cavity within said filter element, said cavity having a longitudinal wall extending into the filter element formed by a continuous section of filter material," and "excess air space in said cavity, said excess air space being unoccupied by the breakable capsule." New Claim 59 recites, *inter alia*, "a generally conically shaped cavity formed of a continuous wall of filter material within said filter element." The prior art relied upon does not disclose these cavity and air space limitations, and accordingly, Claims 54-60 should be allowed.

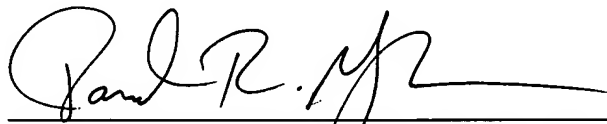
Conclusion

In view of the foregoing, Applicants respectfully request that the rejections of Claims 1-33 and 35-46 be withdrawn and the present application be allowed with all pending claims. Should the Office believe anything further is required to place the application in condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

The Director is authorized to charge Deposit Account No. 03-2469 the fee required under 37 C.F.R. § 1.17(a)(1) a one month extension of time. If an additional fee is required, the Director is authorized to charge any deficiency or credit any overpayment to this deposit account. Moreover, if the deposit account contains insufficient funds, the Director is hereby invited to contact Applicants' undersigned representative to arrange payment.

Respectfully submitted,

Date: April 11, 2005

A handwritten signature in black ink, appearing to read "David R. Yohannan", written over a horizontal line.

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